



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,804	11/18/2003	Margaret Goodwin	MS1-1791US	5203
22801 7590 03/23/2007 LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			EXAMINER ROCHE, TRENTON J	
			ART UNIT	PAPER NUMBER
			2193	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		03/23/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/23/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhptoms@leehayes.com

Office Action Summary	Application No.		Applicant(s)	
	10/715,804		GOODWIN ET AL.	
	Examiner		Art Unit	
	Trenton J. Roche		2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20050225</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is responsive to communications filed 18 November 2003.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a method for developing and installing an application comprising an application framework, a navigation framework, and application lifecycle management components, classified in class 717, subclass 174.
 - II. Claims 12-15, drawn to a computer-readable medium encoded with computer-executable components for defining a scope of an application via various window objects and classes, classified in class 715, subclass 804.
 - III. Claims 16-23, drawn to a computer-readable medium encoded with computer-readable components for identifying, exposing, and defining various navigation-related properties, methods and events, classified in class 715, subclass 804.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group II discusses particulars of the application framework itself. The subcombination has separate utility such as exposing properties via an interface for windows of an application.

Art Unit: 2193

4. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group III discusses particulars of the navigation framework itself. The subcombination has separate utility such as exposing properties of various navigation classes.

5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable.

6. The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

7. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 2193

8. During a telephone conversation with Mr. Lewis Lee, on 29 February 2007, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Claims 1-11 have been examined.

Specification

10. The disclosure is objected to because of the following informalities: on page 6 of the specification, line 17, the word "server" seems to be misspelled as "sever". Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 2-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claims 2-11 recite the limitation "The system recited in claim 1" in line 1. There is insufficient antecedent basis for this limitation in the claim. As the independent claim of the group is directed to a method claim, for purposes of examination, claims 2-11 will be interpreted as reading "The method recited in claim 1"

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as disclosed in claims 1-11 is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and **tangible** result.” (State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d at 1373, 47 USPQ2d at 1601-02.)

Specifically, the claims are directed to a method for developing an application, comprising providing an application framework, providing a navigation framework, and providing application lifecycle management components. However, the language of the claim is such that these components and frameworks are merely provided. While the claim states that the management components define *how* an application is deployed, installed, etc., the claim never positively recites that any application *is* deployed or installed. The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claim is providing component that define how to deploy or install an application which is not a tangible result because simply defining something does not result in a physical transformation of any kind.

On this basis, claims 1-11 are rejected under 35 U.S.C. § 101.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2193

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1-6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,405,364 to Bowman-Amuah.

Per claim 1:

Bowman-Amuah discloses:

- providing an application framework including components that define a scope of the application (Note col. 7 lines 48-55)
- startup and shutdown behavior for the application (Note col. 117 lines 46-56)
- and how the application manages windows and resources (Note col. 7 lines 48-55)
- providing a navigation framework including components that provide navigation functionality, journaling, journal extensibility, and structured navigation (Note col. 88 lines 35-48 and col. 93 lines 35-41. Further, for journaling, note col. 65 lines 64-67)
- providing application lifecycle management components that define how the application is deployed, installed, activated, updated, rolled back, and removed from a computing system (Note col. 14 lines 5-7, col. 62 lines 15-24 and col. 123 lines 43-46.)

substantially as claimed.

Per claim 2:

Note the rejection of claim 1. The framework noted in col. 7 lines 48-55 is made up of objects.

Per claims 3 and 4:

Art Unit: 2193

The rejection of claim 1 is incorporated, and further, Bowman-Amuah discloses managing windows and resources and their behavior as claimed (Note col. 7 lines 51-52).

Per claim 5:

The rejection of claim 1 is incorporated, and further, Bowman-Amuah discloses a component allowing the application to access common window properties regardless of the hosting environment as claimed (“objects that provide default behavior (e.g., for menus or windows)...” in col. 7 lines 51-52. The user can access the default behavior, which is a property, of the window. The system is not concerned with the hosting environment.)

Per claim 6:

Note the rejection of claim 2. As the claim does not set forth any specifics of what the “NavigationApplication” object is, the Examiner interprets as simply a standard object.

Per claim 10:

The rejection of claim 1 is incorporated, and further, note the rejection regarding claim 2.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2193

19. Claims 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman-Amuah.

Per claim 7:

Bowman-Amuah does not explicitly disclose that an object in the application identifies an initial resource to which the application navigates when launched. However, Office Notice is taken that upon launching any software application, it would have been obvious to one of ordinary skill in the art to identify an initial resource for the application to access, as this would enable the application to present a user with a starting screen or other such introductory aspect of the application.

Per claim 8:

The rejection of claim 7 is incorporated, and further, note col. 7 lines 5-29.

Per claim 9:

The rejection of claim 7 is incorporated, and further, note col. 118 lines 13-15.

Per claim 11:

The rejection of claim 1 is incorporated, and further, Bowman-Amuah does not explicitly disclose components persisting across navigations. However, Official Notice is taken that it would have been obvious to one of ordinary skill in the art to have a component or object persist across navigations in an application, as this would enable later processes to utilize the component or object in performing actions associated with the component or object.

Art Unit: 2193

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trenton J. Roche whose telephone number is (571) 272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trenton J Roche
Examiner
Art Unit 2193

TJR


MENG-AL T. AN
SUPERVISORY PATENT EXAMINER
EBC CENTER 2100